REMARKS

I.   <u>Introduction</u>

Claims 32-39, 65-69, and 72-102 are withdrawn.

Claims 40-64 and 70 are pending in this application.

Claims 40, 46-47, 49-52, 57 and 70 are amended.

Claims 40-64 and 70 are rejected on the grounds of non-statutory obviousness-type double patenting in view of claims 1-26 of U.S. Patent No. 6,253,237.

Claims 46-51 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 40-57, 60-62 and 70 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,440,334 to Walters et al. ("Walters").

Claims 58, 59, 63, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Walters.

Applicants traverse these rejections based on the amendments above and the remarks set forth below.

II. Applicants' Reply to the Double Patent Rejection

Claims 40-64 and 70 are rejected on the grounds of nonstatutory obviousness-type double patenting in view of claims 1-26 of U.S. Patent No. 6,253,237.

Applicants file herewith a terminal disclaimer in compliance with 37 C.F.R. § 1.321. Accordingly, it is respectfully requested that the double patenting rejection be withdrawn.

III. Applicants' Reply to Rejection Under 35 U.S.C. §101

Claims 46-51 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse.

Claims 46-51 are directed to an apparatus recited in means plus function form. The claim specifies a "means for retrieving" and "means for storing." It is important to note that such means, as set forth in the specification, are described in the context of any software or firmware being stored either in some form of memory, computing device, or other tangible medium.

As such, claims 46-51 describe embodiments that are fixed to one or more computing devices (i.e., are computing devices programmed to perform the claimed functions). Applicants respectfully submit that computing devices programmed to perform

specific functions qualify as a new and useful machine under 35

U.S.C. § 101 are therefore statutory subject matter[1]. See

Interim Patent Subject Matter Eligibility Guidelines dated

August 24, 2009.

However, to make clear that the claims 46-51 are directed

toward embodiments that are fixed in one or more computing

devices, applicants' have amended independent claim 46 to recite

a computer means and a memory means.

Accordingly, applicants' respectfully submit claims 46-51

are directed to statutory subject matter. As such, withdrawal

of the rejection under 35 U.S.C. § 101 is respectfully

requested.

IV. Applicants' Reply to Rejection Under 35 U.S.C. §102(b)

Claims 40-57, 60-62 and 70 are rejected under 35 U.S.C.

§ 102(b) as being anticipated by Walters. Applicants

respectfully traverse.

Applicants' claimed invention is generally concerned with

methods and apparatus for personalized time-shifted programming.

More particularly, the present invention provides systems and

methods that allow a user to retrieve digital content from a

remote source such as a library server and store it on a local

computing device such as a personal computer. The locally

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[1] For computing devices not directed toward an abstract idea, law of nature, or natural phenomenon.

stored content may then be transferred, in whole or in part, to a mobile playback device that allows a user to listen to the content.

One aspect of the claimed invention is concerned with the customization of playback devices and certain playback features. More specifically, the claimed invention allows a user to specify a playback time that is associated with certain specific content selections. For example, assume a user has a playback device that can provide two hours of audio playback time. With this case, a user may configure the device such that twenty minutes of playback time is dedicated to news, forty minutes to sports, and one hour to an audio novel. This feature is desirable because it allows the user to customize his or her playback device by defining a desired content mix in terms of both content selection and quantity (*i.e.*, playback time allocated to each content selection). It also provides the user with the freedom and flexibility to change the specified content mix to adapt to changing preferences or requirements.

A further aspect of the claimed invention allows the user to specify certain update conditions or policies to be employed when updating or refreshing content. For example, the news portion may be twenty minutes of the most recent news available from a particular source. The sports section may be the most

recent episode of a daily sports talk show, whether or not the user has listened to other stored episodes. The audio novel portion may provide one hour of the audio novel from the most recent consumption point each time the playback device is coupled to the library retrieval device.

The prior art of record, including Walters, fails to show or suggest these features. Walters is purportedly concerned with the broadcast burst transmission of compressed audio/video programs from a stored library to a multiplicity of subscribers. See Walters, Abstract. A device associated with a subscriber receives one or more ordered programs corresponding to the time period of the burst transmission and stores the one or more ordered programs. See Walters, column 6, lines 10-28.

In one configuration, instead of burst transmitting an entire two hour program in 76 seconds, segments of the program are burst transmitted on a different, but predictable schedule. See Walters, column 4, lines 28-32. In the example provided, a two hour program is divided into four segments that each require 19 seconds to transmit. See Walters, column 6, lines 2-9. With this approach, the receiving device can have a reduced memory capacity and thus lower its manufacturing cost. See Walters, column 6, lines 48-54.

However, to maintain continuous decompression and playback of the program, the receiver must receive and store the next

transmitted segment just as the playback of the previously
stored segment completes. That is, the receiver must begin
receiving the next content segment 19 seconds before playback of
the previously received segment finishes. This is because the
next program segment overwrites the prior segment in memory.
See Walters, column 6, lines 41-44.

Transmitting the next program segment that is the right
size at the right time is crucial to the seamless playback of
the program. If the next program segment is received to soon,
it will overwrite the prior segment before it is finished
playing. If the next segment is received too late, there will
be an undesirable gap in playback. If the transmitted program
is the wrong size, similar problems result. Thus, the size and
playback time of program segments described in Walters are
carefully controlled and coordinated by the distribution network
(and thus are not a user specified as recited in applicants'
pending claims).

Claims 40-56 and 70

Independent claims 40, 46, 52, and 70, as amended, recite
in one form or another, updating consumed media content with
respect to a user's specifications. That is, when content is
consumed, it is updated according to the user's specifications,
such as with respect to a user selected playback time. For
example, in paragraphs 17-18 of applicants' published

application, different playback device configuration and update

techniques are described based on how the user desires to use

the content. Thus, it is the user that controls how content

playback is configured and how the consumed media is updated.

In contrast, Walters describes that such content selections

and updates are under strict centralized control. In Walters,

it is the content provider (e.g., a broadcaster) that controls

the size of the segments that are burst transmitted not the

user.

In fact, there is no discussion at all in Walters of

allowing each user to configure the amount of content that is

transmitted or how that content is updated per burst

transmission. As shown above, each piece of content in Walters

must be transmitted in a tightly controlled time slot and be

exactly the right size. If the system of Walters allowed each

user control of how much data is transmitted, Walters would need

to support multiple non-uniform timeslots and content segments.

Such features are not discussed at all in Walters, and if

implemented, would render Walters inoperable.

Moreover, the Office Action relies on Walters at column 6,

lines 41-44 as teaching updating consumed content according to a

user's predetermined specification. (Office Action, Page 5,

Paragraph 4). Applicants respectfully disagrees.

This section of Walters merely states that programs are replaced as consumed using segments rather than entire programs. Nowhere in Walters is it shown or suggested that a user may specify how to update consumed content. Instead, the consumed segment is merely replaced with the next segment in the program by the distribution network according to systems requirements. The size of the segment and when it is transmitted for replacing the consumed content is strictly controlled by the library, not the user.

Accordingly, claims 40-57, 60-62 and 70, as amended, are allowable over Walters.

Claims 57-64

Independent claim 57 recites, in part, a playback device that stores selected content that is "determined automatically based on predetermined user content selections." As shown above, Walters is silent as to user selections for determining anything other than which program or portion thereof to burst transmit. Thus, the reasons set forth above are applicable with equal force and effect and are not repeated here for the sake of brevity.

Accordingly, for at least for the above stated reasons, applicants respectfully request that the rejection of claims 40-57, 60-62 and 70 under 35 U.S.C. § 102(b) be withdrawn.

V. Applicants' Reply to Rejection under 35 U.S.C. §103(a)

Claims 58, 59, 63, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walters. Applicants respectfully traverse.

Applicants submit that claims 58, 59, 63, and 64 are allowable for at least the same reasons as independent claim 57, as explained above.

Thus, for at least the reasons stated above, applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

VI. Examiner Interview

Applicants believe the above clearly demonstrates that the pending claims are allowable. If the Examiner disagrees, the undersigned attorney would welcome the opportunity to have a telephone interview with the Examiner to discuss the case further in an effort to expedite prosecution.

VII. Conclusion

For the foregoing reasons, applicants respectfully submit that the invention as claimed is patentable. Accordingly, reconsideration and allowance of pending claims 40-64 and 70 are respectfully requested.

Respectfully submitted,

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